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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,747	11/20/2000	Benyahia Nasli-Bakir	ANO 6441 PIUS/SWE 05116	4239
27624 7590 08/14/2008 AKZO NOBEL INC. LEGAL & IP 120 WHITE PLAINS ROAD, SUITE 300 TARRYTOWN, NY 10591			EXAMINER FLETCHER III, WILLIAM P	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 08/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/700,747	<b>Applicant(s)</b> NASLI-BAKIR ET AL.	
	<b>Examiner</b> William P. Fletcher III	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39,41-46,56-76 and 78-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39,41-46,56-76 and 78-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/14/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment and remarks filed May 14, 2008, are noted.
2. Claims 39, 41-46, 56-76, and 78-98, remain pending.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on May 14, 2008, was filed after the mailing date of the non-final Office action on November 15, 2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Arguments***

4. The rejections of claim 94 under 35 USC 112, set forth in the prior Office action, are withdrawn in view of the amendment.
5. Applicant's arguments filed May 14, 2008, concerning the prior art rejection set forth in the prior Office action, have been fully considered but they are not persuasive.
  - A. There is not evidence of record that the compositions taught by Lehnert are, in fact, water diluted and would, consequently, function in a deleterious fashion. As such, this argument is mere conjecture and cannot serve to establish the patentability of the claims by weighing against the *prima facie* case of record.
  - B. Applicant's proposition that acid-based hardeners could not be effectively used in resin systems for producing gluelams or laminated timber is not persuasive. The *Principles of Wood Science and Technology* reference, cited by applicant, states: "Most acid phenolic glues give durable joints over long periods"

[p. 63]. Potential negative effects arise only at temperature extremes. Consequently, to assert that all acid-based hardeners result in deterioration of the wood is an overly broad interpretation of this teaching, does not approach the level of a teaching away, especially since the claims recite no temperature, and cannot weigh against the *prima facie* case of record.

C. With respect to the claimed amount of filler, the Examiner has repeatedly noted that the references are silent with respect to the amount of filler and such silence represents a fair teaching of 0% filler. The Examiner maintains this position as Applicant has not yet successfully proved the contrary.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**8. Claims 39, 41-45, 56-59, 70-76, 78-82, 84-87, 89-93, 95, and 98, are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson (EP 0 207 024 A2) in view of Lehnert (WO 89/05221 A1).**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

**9. Claims 46, 83, 88, 96, and 97, are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert, as applied to claims 49, 80, and 87, respectively, above, in further view of Perciwall (EP 0 016 740 A1).**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

B. With specific respect to new claim 96, as first noted by the Examiner in the Office action mailed January 14, 2005, not yet traversed by Applicant, it is clear that, as soon as the components are mixed, curing begins. The particular physical orientation of the strands on the substrate effects the speed and degree of curing; such would have been readily apparent to one of ordinary skill in the art. Consequently, absent clear and convincing evidence to the contrary, it would have been obvious to select the orientation of resin and hardener strands to give the desired curing rate and substrate coverage. In other words, for a quicker cure, strands are applied with a greater degree of overlap so that curing may begin before the substrates are joined. The apex of such overlap being applying

hardener directly on top of the resin. This arrangement inherently prevents contact of the volatile acid in the hardener with the substrate. For a longer cure, strands are applied with a lesser degree of overlap.

C. With respect to new claim 97, differences in concentration will generally not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such subject matter is critical. Further, the ratio of hardener to resin is a result-effective variable effecting the rate and degree of hardening. As such, it would have been obvious to one skilled in the art to optimize this result-effective variable by routine experimentation, absent evidence of criticality. See MPEP 2144.05.

**10. Claims 40 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert, as applied to claims 39 and 76, respectively, above, and further in view of Menger (US 2,015,806 A).**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

**11. Claims 60-64 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert and Toshio (JP 61-040137).**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

**12. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert and Toshio, as applied to claim 60 above, and further in view of Perciwall.**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

**13. Claim 94 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andersson in view of Lehnert and Perciwall.**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

#### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**15. Claims 70 and 76 are each rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 18 of U.S. Patent No. 6,734,275 B2 in view of Andersson (EP 0 207 024 A2).**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

**16. Claim 94 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 18 of U.S. Patent No. 6,734,275 B2 in view of Perciwall (EP 0 016 740 A1 and Andersson (EP 0 207 024 A2).**

A. These claims are rejected for the same reasons set-forth under this heading in the Office action mailed September 13, 2005, and maintained in the final Office action preceding appeal mailed February 22, 2006.

### ***Conclusion***

**17. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM; on campus every Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**/William Phillip Fletcher III/**  
Primary Examiner

August 10, 2008